



UNITED STATES PATENT AND TRADEMARK OFFICE

70
UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,557	01/21/2004	D. James Surmeier	NWESTERN-08739	2838

7590

02/21/2006

David A. Casimir
MEDLEN & CARROLL, LLP
101 Howard Street, Suite 350
San Francisco, CA 94105

EXAMINER

CHONG, KIMBERLY

ART UNIT

PAPER NUMBER

1635

DATE MAILED: 02/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/761,557	SURMEIER ET AL.	
	Examiner	Art Unit	
	Kimberly Chong	1635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 November 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4, 10 and 17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4, 10 and 17 is/are rejected.
- 7) ☒ Claim(s) 17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>11/23/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Application/Amendment/Claims

Applicant's response filed 11/23/2005 has been considered. Rejections and/or objections not reiterated from the previous office action mailed 08/24/2005 are hereby withdrawn. The following rejections and/or objections are either newly applied or are reiterated and are the only rejections and/or objections presently applied to the instant application.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

With entry of the amendment filed on 11/23/2005, claims 4, 10 and 17 are pending in the application.

Specification

The attempt to incorporate subject matter into this application by reference to Kv3.4 nucleic acid having GenBank Accession No. X62841, see page 67, is ineffective because the root words "incorporate" and/or "reference" have been omitted. See 37CFR 1.57(b).

Additionally, the attempt to incorporate subject matter into this application by reference to the Kv3.4 nucleic acid is ineffective because the Kv3.4 nucleic acid appears to be "*essential material*". MPEP 608.01(p) defines *essential material* as "...that which is necessary to (1) describe the claimed invention, (2) provide an enabling disclosure of the claimed invention, or (3) describe the best mode (35 U.S.C. 112)."

Claims 4, 10 and 17 are drawn to a method of manipulating neuronal ion channels comprising transfecting a cell that expressed an mRNA encoding a Kv3.4 protein with a vector encoding an siRNA directed against said mRNA encoding a Kv3.4 nucleic acid described by

Art Unit: 1635

Genbank accession number X62841, however the sequence of the claimed Kv3.4 nucleic acid is not disclosed. The sequence of the Kv3.4 nucleic acid is considered to be *essential material* because it is needed to provide an enabling disclosure of the claimed invention, namely design of an siRNA that binds to portions of the Kv3.4 nucleic acid.

Sequence Compliance

This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825 because the specification, on page 67, recites sequences that do not have the required sequence identifier.

A complete response to this office action must correct the defects cited above regarding compliance with the sequence rules and a response to the action on the merits which follows.

The aforementioned instance of failure to comply is not intended as an exhaustive list of all such potential failures to comply in the instant application. Applicants are encouraged to thoroughly review the application to ensure that the entire application is in full compliance with all sequence rules. This requirement will not be held in abeyance.

Additionally the Kv3.4 nucleic acid, recited in the claim and the specification at page 67, having Genbank accession number X62841 is improper because the Kv3.4 appears to be essential subject matter and therefore needs to be included in the Sequence Listing and referred to by the proper sequence identifier. Rule 37 CFR 1.821 states that sequences, for prior art purposes, referred to in a given application by name and a publication or accession reference,

Art Unit: 1635

need not be included as part of the Sequence Listing, *unless* the referred to sequence is considered “essential material,” per MPEP § 608.01(p). See also MPEP 2422.03.

A complete response to this office action must correct the defects cited above regarding compliance with the sequence rules and a response to the action on the merits which follows.

The aforementioned instance of failure to comply is not intended as an exhaustive list of all such potential failures to comply in the instant application. Applicants are encouraged to thoroughly review the application to ensure that the entire application is in full compliance with all sequence rules. This requirement will not be held in abeyance.

Claim Objections

Claim 17 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 17 is drawn to a siRNA having SEQ ID NO. 3 directed toward a Kv3.4 target wherein the siRNA targets positions 2222-2283 of a Kv3.4 nucleic acid. SEQ ID NO. 3 targets positions 2025-2043 of said Kv3.4 nucleic acid and therefore fails to further limit claim 4.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 1635

Claim 4, 10 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 is drawn to a method manipulating neuronal ion channels comprising transfecting a cell that expressed an mRNA encoding a Kv3.4 protein with a vector encoding an siRNA directed against said mRNA encoding a Kv3.4 nucleic acid wherein said siRNA targets positions 2222-2283 of said Kv3.4 nucleic acid described by Genbank accession number X62841. Claim 17 is drawn to a siRNA having SEQ ID NO. 3 directed toward a Kv3.4 target wherein the siRNA targets positions 2222-2283 of a Kv3.4 nucleic acid

The siRNA having SEQ ID NO. 3 is targeted to positions 2025-2043 of said Kv3.4 nucleic acid (see sequence search rnpbm Result 179) and it is therefore unclear what is the context, i.e. what is the intended basis, for the numbering 2222-2283 in claim 4. Claim 10 is rejected for being dependent on claim 4.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

Art Unit: 1635

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

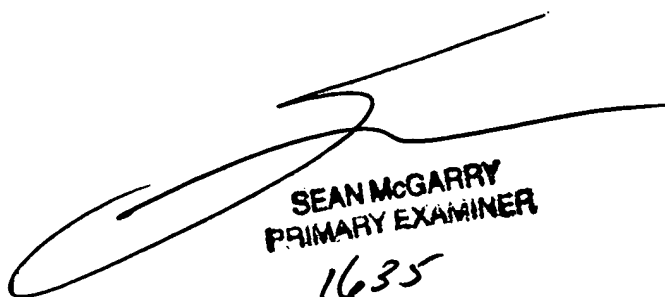
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly Chong whose telephone number is 571-272-3111. The examiner can normally be reached Monday thru Friday between 7-4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached at 571-272-0811. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public. For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

Kimberly Chong
Examiner
Art Unit 1635



SEAN MCGARRY
PRIMARY EXAMINER
1635